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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,423	08/06/2003	Valdemar Portney	VGEN.019A	7328

20995 7590 01/30/2006

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EXAMINER
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WILLSE, DAVID H

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 01/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/635,423		PORTNEY ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Dave Willse		3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11-21-03; 8-23-04</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

Applicant's election without traverse of Species A1 and B1 in the reply filed on October 31, 2005, is acknowledged.

In the Information Disclosure Statement of November 21, 2003, certain references were **not** considered because complete copies (37 CFR § 1.98(a)(2)(iii)) were not presented.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 13-15 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Weinschenk et al., US 6,599,317 B1. The center of a posterior optic **16** or **116** moves anteriorly (Figures 2, 3, 5, and 6; column 2, lines 41-43; column 10, lines 52-55), and the center of the anterior optic **14** or **114** moves anteriorly by a greater amount (column 3, lines 22-25; column 9, lines 38-40).


Claims 1-7, 9, and 12-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Hara et al., *Ophthalmic Surgery*, February 1990, Vol. 21, No. 2, pp. 128-133. Two of the closed loops (figures; page 130, column 2, lines 5-6) are viewed as anterior haptic arms, and the other two are interpreted as the “at least one posterior haptic member” (instant claim 1, line 8) because all four loops have anterior and posterior portions and because the intraocular lens can be tilted such that two of the loops are generally anterior relative to the other two loops. The posterior optic is capable of moving in the forward direction somewhat (page 131, column 1, lines 14-22). Regarding the limitation “second end adapted to be coupled to the eye” (instant claim 1, line 5), the closed loops conform to the capsular bag (page 132, column 1, lines 5-7); moreover, MPEP 2106, section II. C., explains that language which suggests or makes optional but “does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation”; “examples of language that may raise a question as to the limiting effect of the language in a claim” are “adapted to” and “adapted for” clauses. Regarding claims 4 and 5, the closed loops are adapted to be at least indirectly coupled to the zonular fibers of the eye (via the capsular bag). Regarding claim 9, because all four closed loops spiral helically upward in a clockwise direction from the perspective of Figure 2B (page 130, column 2, lines 17-23), forward movement of the

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posterior (lower) optic and the reaction force applied by the capsular bag tend to rotate the anterior (upper) optic in a clockwise direction.

Claims 8, 10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hara et al., *Ophthalmic Surgery*, February 1990, Vol. 21, No. 2, pp. 128-133. Regarding claim 8, grooves would have been an obvious means for affixing the dissimilar materials (page 130, column 2, lines 6-8) in order to provide a stable interlocking of the closed loops into the optics. Regarding claims 10 and 11, Hara et al. contemplate distributing the lens power differently between the two optics (page 131, column 1, lines 22-25), and it was well known in the art at the time of the present invention to combine positive and negative optics in an accommodating intraocular lens, so power changes of approximately 20 diopters (also well known) would have been obvious in order to provide enhanced amounts of accommodation.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse whose telephone number is 571-272-4762. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



**Dave Willse**  
**Primary Examiner**  
**Art Unit 3738**